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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

COMISKEY et al

Atty Ref. 1723-4

Serial No. To be Assigned

Group:

Filed: May 11, 1994

Examiner:

For: REFLECTED LIGHT GLARE
MINIMIZATION FOR ATHLETIC
CONTEST PARTICIPANTS WHILE
PROVIDING A NON-VERBAL
COMMUNICATION

May 11, 1994

Honorable Commissioner of Patents and
Trademarks
Washington, DC 20231

PETITION TO MAKE SPECIAL

Sir:

This petition to make special is submitted pursuant to MPEP 708.02(VIII).
Submitted herewith are the following:

(a) This petition is in writing and the fee of \$130 required by 37 CFR 1.17(i)
is provided.

(b) It is believed that all of the claims are directed to a single invention so
that a restriction requirement will not be necessary. However if restriction is
required, applicant will make an election without traverse as provided for in
MPEP 708.02(VIII).

(c) Enclosed herewith is an information disclosure statement listing
references located in preliminary searches. Three different searches were

performed. One search was performed by the inventor Stephen Comiskey of the commercial literature relating to temporary tattoos, commercially available eye black, and the like; the references listed under "Other Documents" were located during this search. Further a search was made by the undersigned attorney by computer using key words, in DIALOG files 340 (U.S. patents 1950-1994), 351 (U.S. and many foreign patents from 1981-1994), 6 (National Technical Information Service, 1964-1994) and 16 (PTS Prompt 1972-1994). No relevant art was located during this search.

A manual patent search was also done in the records of public search room at the United States Patent and Trademark Office by a professional searcher employed by Nixon & Vanderhye P.C. The references located during that search are the patent references listed on the form PTO-1449. Unfortunately at the time an accurate record was not kept of the areas searched therefore the undersigned cannot say with accuracy what all of the classes and sub-classes of the public search room were searched. However it is known that a number of different sub-classes in Class 428 were searched.

(d) A copy of each of the references is enclosed, the references listed on the form PTO-1449.

(e) A detailed discussion of the references follows: it should be noted, however, that in some cases the discussion of the references is not long because even though the references were located in the search they are not seen as particularly relevant to the invention claimed in the application.

The Sports Illustrated cover illustrates conventional use of eye black by an athlete. The eye black is of random shape and applied as described in the background portion of the instant application specification. The three exemplary tattoo sheets produced by J.B. Marketing Inc. describe how temporary tattoos that are produced according to the invention would be applied, and also illustrate a wide variety of shapes and words for temporary tattoos. It is noted, however, that by design the tattoos are reflective and multi-colored, in most cases containing bright colors. None of them provide the non-reflective colored and finished exterior provided according to the present invention, nor are they designed to function as does eye black.

The JB Manufacturing advertising brochures and flyers show other examples of the wide variety of different types of tattoos sold commercially, and includes illustration of some of the tattoos on people's bodies. The "Game Faces" brochure shows a variety of different other types of temporary tattoos, in this case the tattoos again being typically shining (reflective) and colorful, rather than dull or matte. The Game Faces brochure also shows tattoos applied to people's faces, however none of the illustrations show applying the tattoos under the eyes, and the brochure specifically provides (the last page) "Transfers should not be applied near the eyes or on sensitive skin". The Anderson's Catalog pages show skin transfers that can be worn on the face, arms and legs, but again not under the eyes where conventional eye black would be applied, and the transfers are reflective rather than dull or matte, and typically colorful.

With respect to the patents, Humason et al show a conventional decal construction, Humason et al specifically referenced on page 9 of the instant application specification. Miller et al also show conventional decals, in this case for placement on the nails of person's fingers or toes, and that reference is also specifically mentioned on page 9 of the instant application specification. The other patents are general teachings of decals or transfers relating to the particular nature of their construction or the method of construction thereof, however they do not relate to the features of the claimed invention comprising application of dull or matte finished material underneath a human's eyes to function like conventional eye black but providing a message at the same time.

Early grant of this petition to make special and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



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